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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,898	04/06/2001	Maroka Ueda	205727US-2	6383
22850	7590	10/20/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			PHAM, THIERRY L	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/826,898	Applicant(s) UEDA ET AL.	
	Examiner Thierry L. Pham	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8,9,11,13-16 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8,9,11,13-16 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/30/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

- This action is responsive to the following communication: an Amendment filed on 8/15/05.
- Claims 1-2, 4-6, 8-9, 11, 13-16, 21-25 are pending; claims 3, 7, 10, 12, 17-20 have been canceled.

#### ***Claim Rejections - 35 USC § 112***

Claims 1, 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Limitation/feature “acquire result information from an operation” as cited in claim 1, is unclear. The examiner is unclear to what “operation” the applicant is referring to.

Claims 1, 8, 15, 21, 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Limitation/feature “a portion of the image information covered by an element of higher order is not included by the edited first image information” is unclear. The examiner is unclear to what “high order” represents. The examiner cannot locate the definition of “high order” anywhere within an original filed specification.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-6, 8-9, 11, 13-16, 21-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohtsuka (US 6327049).

Regarding claim 1, Ohtsuka discloses an image processing apparatus (laboratory print server apparatus, fig. 2) comprising:

- a communication unit (network 10, fig. 1) configured to communicate with an information processor apparatus (client computer 5, figs. 1-2), the information processing apparatus configured to operate on image information;
- a storage configured to store first image information (template server for storing plurality of high resolution templates 4, fig. 2) which represents at least one element; and
- a controller configured to send second image information (order file 6 with low resolution templates downloaded from the server, fig. 2, col. 7, lines 38-42) to the information processing apparatus (user terminal 5, figs. 2-3), said second image information represents the at least one element and an amount of the second image information is smaller than an amount of the first image information (inherently, high resolution image from the template server is higher/larger than the low resolution template sent from the client apparatus, figs. 2-4, col. 6, lines 60-67 to col. 7, lines 1-50), wherein the controller is further configured to acquire result information from an operation (print order information as shown in tables 1-8 includes finishing options, cols. 10-13) which is executed for the sent second image information on the information processing apparatus, the result information includes order information indicating an order of the images in a direction perpendicular (vector position, col. 2, lines 42-55) to a display screen;
- the controller is further configured to edit the first image information (laboratory server apparatus for editing high resolution templates with respect to print order file along with finishing options sent from the client apparatus, fig. 2-4, cols. 7-8), wherein the first image information stored in the storage is expanded (expands the high resolution templates via image server, fig. 3, cols. 7-8), the first image information is edited according to the acquired result information including the order information, so that if at least two elements superimpose each other (i.e. image superimpose with texts as shown in fig. 6), a portion of the image information covered by an element of higher order (correction can be manually carry out by users for any undesired features, col. 2, lines 42-55 and col. 10, lines 60-65) is not included by the edited first image information; and
- the controller is further configured to send the edited first image information (edited image is sent to user terminal 5, fig. 2) to the information processing apparatus.

Regarding claim 2, Ohtsuka further discloses the image processing apparatus according to claim 1, wherein the controller is further configured to execute at least one of a moving process, an enlargement process, a reduction process and a deletion process (i.e. image processing specification, tables 3-8, cols. 11-13) on the at least one element during said editing of the first image information in the intermediate process.

Regarding claim 4, Ohtsuka further discloses the image processing apparatus according to claim 1, wherein a network is configured to connect among the image processing apparatus, the information processing apparatus and other information processing apparatuses (network 10, fig. 1), and the controller is configured to broadcast the first image information which is edited and composed to a plurality of desired information processing apparatuses (i.e. apparatus 1 and 5, fig. 1) of the information processing apparatus and the other information processing apparatuses.

Regarding claim 5, satellite communication network is well known and wide available in the art.

Regarding claim 6, Ohtsuka further discloses an image processing apparatus (laboratory print server apparatus, fig. 2) comprising: a communication unit (network 10, fig. 1) configured to communicate with an information processing apparatus (user terminal 5, figs. 2-3) configured to process first image information and second image information in association with each other, both of the first image information and the second image information representing at least one element and the amount of the second image information being smaller an amount that of the first image information (inherently, high resolution image from the template server is higher/larger than the low resolution template sent from the client apparatus, figs. 2-4, col. 6, lines 60-67 to col. 7, lines 1-50); an image processor (ref. 2, fig. 2) configured to receive the second image information from the information processing apparatus (client apparatus, fig. 1) via the communication unit, configured to display the received second image information on a given display device (display device, 2a-2c, fig. 1), configured to receive an operation instruction (print

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order information as shown in tables 1-8, cols. 10-13) for the displayed second image information, configured to process the displayed second image information according to the operation instruction and sending result information representing the processed and displayed second image information to the information processing apparatus; and an output controller (laboratory print server, fig. 2) configured to receive the first image information (high resolution template, fig. 2) via the communication unit, the first image information being edited according to the result information on the information processing apparatus, and configured to cause a given printing device (print, fig. 2) to print the received first image information, and wherein the operation instruction includes adding process for adding additional information (i.e. text as shown in fig. 6) to the displayed second image information, the image processor saves the additional information, and the output controller executes a superimpose process (superimpose image with text as shown in fig. 6) for the received first image information and the saved additional information and cause the given printing device (print edited image, fig. 2) to print a result of the superimpose process.

Regarding claims 8-9, 11: Claims 8-9, 11 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 1-2, 4 and 6; therefore, claims 8-9, 11 are rejected for the same rejection rationale/basis as described in claims 1-2, 4, and 6 above.

Regarding claims 13-14: Claims 13-14 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 1-2, 4 and 6 and/or combination thereof; therefore, claims 13-14 are rejected for the same rejection rationale/basis as described in claims 1-2, 4, and 6 above.

Regarding claim 15-16: Claims 15-16 corresponds to claims 1-2, 4, and 6 and/or combinations thereof except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers/printers have some type of computer readable memory medium for storing computer programs, hence claims 15-16 would be rejected using the same rationale as in claims 1-2, 4, and 6.

Regarding claims 21-22 recite limitations that are similar and in the same scope of invention as to those in claims 1-2 above; therefore, claims 21-22 are rejected for the same rejection rationale/basis as described in claims 1-2.

Regarding claims 23-25: Claims 23-25 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 1-2, 4, and 6 and/or combination thereof; therefore, claims 23-25 are rejected for the same rejection rationale/basis as described in claims 1-2, 4, and 6 above.

### *Response to Arguments*

Applicant's arguments filed 8/15/05 have been fully considered but they are not persuasive.

- The applicants argued the cited prior art of record (US 6327049 to Ohtsuka) fails to teach and/or suggest, inter alia, the claimed output controller configured to cause a given printing device to print the received first image information. Ohtsuka's user terminal 5 does not perform any printing. A laboratory system printing processed images that were ordered from an user terminal, as taught by Ohtsuk, is not an image processing including an output controller configured to cause a given printing device to print the received first image information.

In response, the examiner disagrees with the applicants' arguments. None of the independent claims indicate that the edited image is transmitted back to the information processing apparatus (i.e. client computer) for printing. As taught by Ohtsuka, an edited image processed by laboratory system is outputted ("PRINT" as shown in fig. 2).

- Regarding claims 1, 8, 15, 21, and 23, the applicants argued the cited prior art of record (US 6327049 to Ohtsuka) fails to teach and/or suggest "order information indicating the order of the images and image information covered by an element of higher order".

In response, the applicants are argued subject matters that are not previously cited. In addition, newly added features "order information indicating the order of the images and image

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information covered by an element of higher order" is nowhere to be found within an original filed specification.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

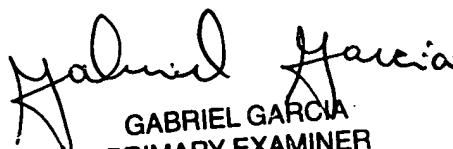
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

  
GABRIEL GARCIA  
PRIMARY EXAMINER